

### REMARKS

Claims 34-53 are pending in this application. Claims 43, 49, 52 and 53 are amended. No new matter is added herein. Claims 34, 40, 43, 50, 51, and 52 are independent.

Claims 43 and 52 have been amended to correct minor editorial errors.

Claims 49 and 53 stand rejected under 35 USC §112, second paragraph, as including language lacking antecedent basis. Claims 49 and 53 are amended herein to cure the noted defect and not for any other purpose. It is respectfully requested that the Examiner reconsider and withdraw the 35 USC §112 rejection in view of the amendment of claims 49 and 53.

Claims 34-38, 40-47, and 49-53 stand rejected under 35 USC §102 as being anticipated by U.S. Patent No. 5,699,528, hereafter referred to as Hogan. The rejection is respectfully traversed.

Claims 39 and 48 stand rejected under 35 USC §103(a) as being obvious over Hogan in view of U.S. Patent No. 6,029,141, hereafter referred to as Bezos. The rejection is respectfully traversed.

Hogan discloses two embodiments of an electronic bill presentment service. In both embodiments, a bill image is received from a biller and formatted for presentation (see, for example, column 4, lines 53-67, column 5, lines 53-57, and column 9, lines 50-53). In the first embodiment, a subscriber retrieves the stored billing information from the bill service via the World Wide Web (see, for example, column 2, lines 32-35), and in the second embodiment, the stored billing information is transmitted to the subscriber as an e-mail message by the bill service (see, for example, column 2, lines 48-50).

Independent claim 34 requires, at least in part, a transmission of a notice, according to an e-mail protocol, that indicates the availability of billing information, a transmission of a request, in response to the notice and according to a protocol other than an e-mail protocol, to receive the billing information, and a transmission of billing information in response to the request. Independent claim 50 requires, at least in part, a first network server for transmitting, via an e-mail protocol, a notice indicating availability of billing information, and a second network server for receiving, via a protocol other than e-mail, a request to receive the billing information responsive to the notice. The Examiner rejects claims 34 and 50 on the same grounds, as such the rejections of claims 34 and 50 will be addressed together below.

The Examiner points to column 5, lines 53-61, of Hogan as teaching the transmission of a notice of bill availability according to an e-mail protocol, to column 4, lines 14-22, and column 5, line 44, through column 6, line 30, as teaching the transmission of a request for billing information in response to the notice and according to a protocol other than an e-mail protocol, and to column 6, lines 11-30, as teaching the transmission of billing information in response to the request. It is respectfully submitted that the Examiner's understanding of Hogan is mistaken.

In the Examiner-referenced text, which is directed to the first Hogan embodiment, discloses transmitting an e-mail to a subscriber only if each of two conditions have been met. According to Hogan, this e-mail will only be sent if the subscriber has not logged on to the bill service and a bill is due within a predetermined period of time. Thus, the Examiner-referenced e-mail is not a notice

of availability of billing information, but rather a notice sent to inform a subscriber of a pending bill due date.

Hogan is silent as to any activity that may or may not occur after the transmission of this e-mail. Thus, Hogan does not teach or suggest transmission of a request for billing information in response to a notice of availability of billing information, as required by claims 34 and 50. At best, the Examiner's arguments in rejecting claims 34 and 50 regarding the required responsive transmission of a request for billing information are speculative.

Further, Hogan does not disclose what any contents might be of the e-mail transmitted if both a subscriber has not logged on and a bill is due. The Examiner argues that the bill service transmitted e-mail contains a URL of the bill service. However, Hogan simply does not disclose that the e-mail includes an URL of the bill service company. Hogan does disclose, in column 3, lines 44-46, a URL of the bill service being sent to a subscriber via a different e-mail. This e-mail transmission relates to the subscriber enrolling with the bill service, not to the e-mail Hogan transmits if both a subscriber has not logged on to the bill service provider and a bill is due within a predetermined period. The URL is sent to the subscriber to inform the subscriber how to access the bill service via the World Wide Web. In any event, it should be noted that claims 34 and 50 do not require that the notice of availability of billing information sent via an e-mail include a URL.

Also, regarding independent claim 50, Hogan does not disclose a first and a second network server. Rather, as seen in Figure 1, Hogan discloses a single server (detail 160) for communicating with a subscriber.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §102 rejection of independent claims 34 and 50, as well as claims 35-39, which depend from claim 34.

The dependencies of independent claim 34 recite further features that are not disclosed or suggested by Hogan. For example, claim 35 requires formatting of billing information for presentation in response to receipt of the request for billing information. The Examiner points to Figure 11 as disclosing this feature. It is respectfully submitted that Figure 11 in no way teaches or suggests this requirement. Figure 11 is merely a representation of an electronic bill presented via e-mail (see column 3, lines 33-34, and column 11, lines 16-25).

Hogan clearly teaches that billing information received from a biller is formatted by the bill service as soon as that information is received (see column 5, lines 53-57, and column 9, lines 50-54), not responsive to a request to receive the billing information. In the first embodiment, formatted billing information is stored for eventual access by a subscriber. In the second embodiment, formatted billing information is transmitted to a subscriber via e-mail upon completion of the formatting. Hogan simply does not teach or suggest formatting billing information in response to a request to receive that billing information. Rather, formatting is performed as soon as billing information is received from a biller.

Claim 37 requires that the notice include information indicating a location of the available billing information. Claim 38 requires that the information indicating the location be a hyper-link, and that the hyper-link is selected to transmit the request. The Examiner points to column 4, lines 14-22, and column 5, line 44, through column

6, line 30, as disclosing these features. It is respectfully suggested that the Examiner-referenced text does not teach or suggest these features.

Rather, column 4, lines 14-22, is a general discussion of home pages and navigation within home pages. This does not teach or suggest the requirement of claim 37 of location information included in a notice of bill availability, nor the requirement of claim 38 that the location information be a hyper-link.

Column 5, line 44, through column 6, line 30, discloses, as discussed above, a delivery of a URL of the bill service to a subscriber via e-mail as a part of registration for the services of the bill service. This e-mail is not a notification of available billing information. Rather, this e-mail merely informs a subscriber how to access the bill service via the World Wide Web. As discussed in column 6, lines 10-21, this URL points to a home page associated with the bill service. From this home page, a subscriber then must access another Web page for presentation of billing information (in particular, see Figure 3). Hogan in fact teaches against a notice of bill availability including a location identifier of available billing information, as the only location identifier disclosed (the URL of the bill service) directs a subscriber to a home page, not billing information.

Accordingly, the Examiner is courteously requested, for at least these reasons, to reconsider and withdraw the rejection of the dependencies of claim 34.

Independent claim 40 requires, at least in part, transmission of an e-mail notice that indicates availability of billing information, transmission of an e-mail request to receive the billing information responsive to the notice, and transmission of billing information responsive to the request. Independent claim 51 requires, at least in part, a memory for storing billing information, and a processor for transmitting

an e-mail indicating availability of billing information and for receiving an e-mail request for the available billing information responsive to the notice. Independent claims 40 and 51 have been rejected upon the same grounds, and as such will be addressed together below.

The Examiner points to Figure 1 and column 9, lines 7-19, of Hogan as teaching transmission of an e-mail notice indicating availability of billing information, to column 9, lines 61-64, of Hogan as teaching transmission of an e-mail request to receive the billing information in response to the e-mail notice, and to Figures 10 and 11 as teaching transmission of billing information in response to the request. It is again respectfully submitted that the Examiner's understanding of Hogan is mistaken.

Figure 1 shows a subscriber's computer (detail 100) in communication with a bill service computer (detail 160) via the Internet. Additionally, Figure 1 shows the bill service computer in communication with a bill capture device (detail 150), which is in communication with multiple payee (biller) computers (details 107-1 through 107-k). Figure 10 depicts a user presentation of unopened and unpaid bills transmitted to a subscriber via e-mail, and Figure 11, discussed above, depicts a user presentation of a bill transmitted to a subscriber via e-mail.

Column 9, lines 7-19, which is directed to the second Hogan embodiment, discloses the bill service transmitting an e-mail message that includes formatted bill data. As disclosed in column 9, lines 50-54, the bill service receives billing data from a payee, formats the billing data in the form of an e-mail, and then transmits the e-mail (bill) to the subscriber's e-mail address. Thus, this e-mail is not a notice of

availability of billing information, as required by claims 40 and 51, but rather the billing information itself.

The Examiner points to column 9, lines 61-64, as disclosing the required transmission of an e-mail request to receive the billing information. This Examiner-referenced text discloses that whenever a subscriber opens an e-mail to view a bill, an acknowledgement message is transmitted to the bill service indicating such. This acknowledgement message is transmitted "[u]tilizing a standard receipt confirmation feature of the e-mail service" (column 9, lines 61-62). This acknowledgement message is in no way an e-mail request to receive available billing information, as required by claims 40 and 51. This is especially true in light of the fact that billing information has already been delivered to the subscriber as an e-mail message prior to transmission of the acknowledgement message, which itself can only be transmitted after a subscriber opens the e-mail containing the billing information.

Finally, the Examiner points to Figures 10 and 11 as disclosing transmission of billing information responsive to a request for such. The Examiner's position is not understood, as Figures 10 and 11 are each representations of information that can be displayed on a subscriber's computer after billing information has been transmitted to the subscriber via e-mail. It is respectfully requested that if the rejection of claims 40 and 51 based upon Figures 10 and 11 is maintained that the Examiner provide rationale for the rejection.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §102 rejection of independent claims 40 and 51, as well as claims 41 and 42, which depend from claim 40.

Independent claim 43 requires, at least in part, a notice indicating availability of billing information transmitted according to a network protocol other than e-mail, a request to receive the billing information transmitted responsive to the notice and also according to a network protocol other than e-mail, and a transmission of billing information responsive to the request. Independent claim 52 requires, at least in part, a memory for storing billing information and at least one processor for transmitting a notice indicating availability of a bill via a network protocol other than an e-mail protocol, and for receiving a request to receive the bill via a network protocol other than an e-mail protocol. Claims 43 and 52 have been examined together, and as such will be addressed together.

The Examiner points to Figure 3 and column 6, lines 9-16, of Hogan as teaching transmission of a notice of availability of billing information according to a network protocol other than an e-mail protocol, to column 5, line 62, through column 6, line 30, of Hogan as teaching transmission of a request, according to a network protocol other than an e-mail protocol, to receive the billing information responsive to the notice, and to column 6, lines 11-30, of Hogan as teaching transmission of the billing information in response to the request. It is again respectfully submitted that the Examiner's understanding of Hogan is mistaken.

In particular, the Examiner argues that Figure 3 and column 6, lines 9-16, disclose transmission of a notice of availability of billing information according to a network protocol other than e-mail. Figure 3 depicts a home page of the bill service presented via the World Wide Web in accordance with the first Hogan embodiment. The home page includes links to separate user interfaces for performing certain functions, such as obtaining account balances (detail 201), receiving and paying bills



(detail 203), and selecting new payees (detail 205). As best understood, the Examiner seems to construe the home page of Figure 3, described in column 6, lines 9-16, as presentation of a notice of available billing information.

Figure 3 shows, at detail 203, a link to a user presentation for receiving and paying bills. Detail 203 is the only detail of Figure 3 that relates to bills. In order for this link to be a notice of available billing information this link would have to be selectively displayed, i.e., only presented when billing information is available.

Hogan in no way teaches or suggests that this link is selectively presented. Rather, with reference to column 4, lines 14-22, Hogan teaches that the details of the home page of Figure 3 are always displayed. In particular, Hogan teaches that the home page “furnishes information about the service offered by the provider through use of graphic images, sound, hyperlink choices, etc. With that information, the user is guided through the home page to select the service and desired service features” (column 4, lines 17-22). Thus, Hogan in fact teaches against the home page of Figure 3 being a notice of available billing information, as detail 203 “receive and pay bills” is always present, irrespective of billing information being available.

The Examiner also argues that Hogan teaches transmitting a request, via a protocol other than an e-mail protocol, to receive available billing information responsive to a notice of availability of billing information. This is not supported by the Examiner-referenced text. Rather, column 5, line 62, through column 6, line 30, discloses a subscriber requesting access to a “receive and pay bills” user interface. As should be understood from the discussion above, this access request is not made in response to a notice of availability of billing information. Rather, this access

request is made from a home page of the bill service through which the subscriber is presented multiple service options.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the 35 USC §102 rejection of independent claims 43 and 52, as well as claims 44-49, which depend from claim 43, and claim 53, which depends from claim 52.

As should be understood from the discussion of dependent claims 35-39 above, dependent claims 44-49 and 53 recite further features that are not disclosed by Hogan. Accordingly, for at least the same reasons discussed above in relation to claims 35-39, the Examiner is courteously requested to reconsider and withdraw the rejection of claims 44-49 and 53.

Regarding the 35 USC §103(a) rejection of dependent claims 39 and 48, the Examiner acknowledges that Hogan does not teach the requirement that a hyper-link indicating a location of available billing information included in a notice of availability of billing information be an icon. The Examiner looks to Bezos for an icon. Bezos is directed to selling goods via the Internet, not electronic presentment of billing information. Bezos teaches a user selectable icon to link to a merchant's Web site.

As should be understood from the discussion above, a combination of Bezos with Hogan would not provide the invention of claim 39, nor the invention of claim 48. That is, neither Hogan nor Bezos teach or suggest the requirements of independent claim 34, from which claim 39 depends, or independent claim 43, from which claim 48 depends. As such, a combination of the two does not teach or suggest the invention of claim 39, or the invention of claim 48.

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For at least these reasons, it is respectfully requested that the Examiner reconsider and withdraw the rejections of claims dependent claims 39 and 48.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 (1158.41315CC4) and please credit any excess fees to such deposit account.

Respectfully submitted,

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